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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,571	01/26/2001	Ahmad Tawil	016295.0635	7613

7590 01/02/2008

Khannan Suntharam
Baker Botts L.L.P.
One Shell Plaza
910 Louisiana Street
Houston, TX 77002-4995

EXAMINER	
LEE, PHILIP C	

ART UNIT	PAPER NUMBER
2152	

MAIL DATE	DELIVERY MODE
01/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/770,571	TAWIL ET AL.	
	Examiner	Art Unit	
	Philip C. Lee	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-13,15-20,22 and 29-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-13,15-20,22 and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. This action is responsive to the amendment and remarks filed on October 18, 2007.

2. Claims 1-5, 7-13, 15-20, 22 and 29-33 are presented for examination and claims 6, 14, 21, 23-28 and 34 are cancelled.

3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 103

4. Claims 1-3, 5, 7-8, 29-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunlock, U.S. Patent 6,606,630 (hereinafter Gunlock) in view of Blumenau et al, U.S. Patent 6,931,440 (hereinafter Blumenau), and further in view of Blumenau et al, U.S. Patent Application Publication 2002/0083339 (hereinafter Blumenau et al).

5. Gunlock, Blumenau and Blumenau et al were cited in the previous office action.

6. As per claim 1, Gunlock taught the invention substantially as claimed comprising:

a high speed network interconnect (col. 6, lines 17-26; fig. 1) ;

multiple target devices coupled to the high speed network interconnect, wherein each target device has a unique hardware address (fig. 1; col. 6, lines 17-26; col. 8, lines 13-25);

multiple host devices, wherein each host device comprises a host bus adapter operable to perform a port login with a target device (col. 4, lines 58-63; col. 6, lines 32-48; col. 8, lines 25-27); and

a unique hardware address table stored in a memory location accessible by each host bus adapter (col. 6, lines 40-43), wherein the unique hardware address table stores the unique hardware address of every target device that each respective host is to access (col. 9, lines 54-62; col. 8, lines 13-27, 38-47).

7. Gunlock did not teach not attempting to perform a port login with a target device unless the unique hardware address of that target device is present on the unique hardware address table. Blumenau taught a similar system wherein a centralized unique hardware address table separate from each host bus adapter (col. 16, lines 3-14) and wherein a unique hardware address of a target device must be present in a unique hardware address table to perform a port login with the target device (col. 16, lines 3-14) (i.e., a device cannot attempt to perform a port login unless the device obtain the unique hardware address (e.g., port's ID) of a target device from a directory. Therefore, the unique hardware address of the target device must be present in the directory.).

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock and Blumenau because Blumenau's teaching of a unique hardware address must be present in order to perform port login would increase the

reliability in Gunlock's system by allowing a component of the computer system (e.g., host bus adapter) to access to the correct target device (e.g., logical volume) (col. 12, lines 25-31).

9. Gunlock and Blumenau did not teach the unique hardware address table stores the unique hardware address of authorized target devices. Blumenau et al taught a centralized unique hardware address table (page 3, paragraph 22), wherein the unique hardware address table stores the unique hardware address of every target device that each respective host is authorized to access (page 5, paragraphs 41, 44 and 45).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau and Blumenau et al because Blumenau et al's teaching of storing the unique hardware address of every target device that each respective host is authorized to access would increase the security of Gunlock's and Blumenau's systems by preventing a host device from accessing target device without authorization (page 7, paragraph 56)

11. As per claim 2, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 1 above. Gunlock further taught wherein the unique hardware address is a port name (col. 8, lines 21-25).

12. As per claim 3, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claims 1 above. Gunlock further taught wherein the unique hardware address is a node name (col. 8, lines 21-25).

13. As per claim 5, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 1 above. Gunlock further taught wherein at least one target device is a storage device (col. 6, lines 17-24; col. 7, lines 19-20).

14. As per claims 7 and 8, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 1 above. Gunlock further taught wherein the high speed network interconnect is a high speed optical network interconnect (col. 6, lines 17-21).

15. As per claim 29, Gunlock taught the invention substantially as claimed comprising:

a memory (col. 6, lines 40-43);

a unique hardware address table stored in a memory and accessible by the host bus adapter(col. 6, lines 40-43), operable to contain one or more unique hardware address corresponding to one or more target device with which the host bus adapter is to access(col. 9, lines 54-62; col. 8, lines 13-27).

16. Gunlock did not specifically teach attempting to perform a port login. Blumenau taught a similar system wherein a centralized unique hardware address table separate from each host bus adapter (col. 16, lines 3-14) and wherein a unique hardware address of a target device must be

present to perform a port login with the target device (col. 16, lines 3-14) (i.e., a device cannot attempt to perform a port login unless the device obtain the unique hardware address (e.g., port's ID) of a target device from a directory. Therefore, the unique hardware address of the target device must be present in the directory.).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock and Blumenau because Blumenau's teaching of a unique hardware address must be present in order to perform port login would increase the reliability in Gunlock's system by allowing a component of the computer system (e.g., host bus adapter) to access to the correct target device (e.g., logical volume) (col. 12, lines 25-31).

18. Gunlock and Blumenau did not teach the unique hardware address table stores the unique hardware address of authorized target devices. Blumenau et al taught a centralized unique hardware address access table (page 3, paragraph 22), operable to contain one or more unique hardware addresses corresponding to one or more target devices with which the host bus adapter is authorized to access (page 5, paragraphs 41, 44 and 45).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau and Blumenau et al because Blumenau et al's teaching of storing unique hardware address corresponding to one or more target devices with which the host bus adapter is authorized to access would increase the security

of Gunlock's and Blumenau's systems by preventing a host device from accessing target device without authorization (page 7, paragraph 56).

20. As per claim 30, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 29 above. Gunlock further taught wherein the unique hardware address is a port name (col. 8, lines 21-25).

21. As per claim 31, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 29 above. Gunlock further taught wherein the unique hardware address is a node name (col. 8, lines 21-25).

22. As per claim 33, Gunlock, Blumenau and Blumenau et al taught the invention substantially as claimed in claim 29 above. Gunlock further taught wherein the target device is a storage device (col. 6, lines 17-24; col. 7, lines 19-20).

23. Claims 16-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunlock, Blumenau (6,931,440) and Blumenau et al, U.S. Patent 6,665,714 (hereinafter Blumenau et al, 6,665,714) in view of Blumenau et al (2002/0083339).

24. Blumenau et al, U.S. Patent 6,665,714 was cited in the last office action.

25. As per claim 16, Gunlock taught the invention substantially as claimed for managing a port login performed by a host bus adapter for a host that is communicatively coupled to a fabric, wherein one or more target devices, each having a unique hardware address, are coupled to the fabric (fig. 1, lines 17-26; col. 8, lines 13-25); comprising the steps of:

storing the unique hardware address of selected target devices to a unique hardware address access table (col. 9, lines 37-40, 54-62).

26. Gunlock did not teach not attempting to perform a port login with a target device unless the unique hardware address of that target device is present on the unique hardware address table. Blumenau taught a similar system comprising the step of: storing the unique hardware address of selected target devise to a centralized unique hardware address access table (col. 16, lines 3-28) wherein a unique hardware address of a target device must be present in a unique hardware address table to perform a port login with the target device (col. 16, lines 3-14) (i.e., a device cannot attempt to perform a port login unless the device obtain the unique hardware address (e.g., port's ID) of a target device from a directory. Therefore, the unique hardware address of the target device must be present in the directory.).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock and Blumenau because Blumenau's teaching of a unique hardware address must be present in order to perform port login would increase the reliability in Gunlock's system by allowing a component of the computer system (e.g., host bus adapter) to access to the correct target device (e.g., logical volume) (col. 12, lines 25-31).

28. Gunlock and Blumenau did not teach querying for available target devices. Blumenau et al (6,665,714) taught from the host bus adapter, querying the fabric for available target devices; receiving at the host bus adapter an identification of available target devices (col. 6, lines 62-col. 7, line 12; col. 8, lines 35-36; col. 21, lines 67-col. 22, lines 14); and selecting target devices that may be accessed by the host from the identification of available target devices (col. 22, lines 14-20).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau and Blumenau et al (6,665,714) because Blumenau et al's (6,665,714) method of querying the fabric for available target devices would increase the efficiency of Gunlock's and Blumenau's systems by avoiding login attempt to unavailable target devices by the host.

30. Gunlock, Blumenau and Blumenau et al (6,665,714) did not explicitly teach target devices which the host bus adapter is authorized to access. Blumenau et al (2002/0083339) taught unique hardware address of every target device that each respective host is authorized to access (page 5, paragraphs 41, 44 and 45).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) because Blumenau et al's (2002/0083339) teaching of storing

the unique hardware address of every target device that each respective host is authorized to access would increase the security of Gunlock's, Blumenau's and Blumenau et al (6,665,714) systems by preventing a host device from accessing target device without authorization (page 7, paragraph 56).

32. As per claim 17, Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claim 16 above. Gunlock further taught wherein the unique hardware address is a port name (col. 8, lines 21-25).

33. As per claim 18, Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claim 16 above. Gunlock further taught wherein the unique hardware address is a node name (col. 8, lines 21-25).

34. As per claim 19, Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claim 16 above. Blumenau et al (6,665,714) further taught wherein the unique hardware address is a World-Wide Name (col. 6, lines 65-67; col. 22, lines 4-11).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) because Blumenau et al's (6,665,714) teaching of World-Wide

Name would enhance their systems by providing a unique identification for identifying each storage device (col. 22, lines 7-11).

36. As per claim 20, Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claim 16 above. Gunlock further taught wherein the target device is a storage device (col. 6, lines 17-24; col. 7, lines 19-20).

37. As per claim 22, Gunlock, Blumenau, Blumenau et al (6,665,714) and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claim 16 above. Gunlock further taught wherein the high speed network interconnect is a high speed optical network interconnect (col. 6, lines 17-21).

38. Claims 4, 9-13, 15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunlock, Blumenau and Blumenau et al (2002/0083339) in view of Blumenau et al, U.S. Patent 6,665,714 (hereinafter Blumenau et al, 6,665,714).

39. As per claims 4 and 32, Gunlock, Blumenau and Blumenau et al (2002/0083339) taught the invention substantially as claimed in claims 1 and 29 above. Gunlock, Blumenau and Blumenau et al (2002/0083339) did not explicitly teach the unique hardware address is a World-

Wide Name. Blumenau et al, 6,665,714, taught wherein the unique hardware address is a World-Wide Name (col. 6, lines 65-67; col. 22, lines 4-11).

40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) because Blumenau et al's (6,665,714) teaching of World-Wide Name would enhance Gunlock's, Blumenau's and Blumenau et al's (2002/0083339) systems by providing a unique identification for identifying each storage device (col. 22, lines 7-11).

41. As per claim 9, Gunlock taught the invention substantially as claimed for managing the port login performed by a host bus adapter for a host that is communicatively coupled to a fabric, wherein one or more target devices, each having a unique hardware address, are coupled to the fabric (fig. 1, lines 17-26; col. 8, lines 13-25) comprising:

determining whether the unique hardware address of an available target device is present on a unique hardware address table stored in a memory location accessible by the host bus adapter, wherein the unique hardware address table contains the unique hardware addresses of each target device that the host is to access (col. 8, lines 13-27; col. 6, lines 37-42).

42. Gunlock did not teach performing a port login with target device whose unique hardware address is present. Blumenau taught a similar system wherein a centralized unique hardware address table separate from each host bus adapter (col. 16, lines 3-14), wherein the unique hardware address table stores unique hardware address of a target device must be present to

perform a port login with the target device (col. 16, lines 3-14) (i.e., a device cannot attempt to perform a port login unless the device obtain the unique hardware address (e.g., port's ID) of a target device from a directory. Therefore, the unique hardware address of the target device must be present in the directory.), and performing a port login with each target device whose unique hardware address is present on the unique hardware address table (col. 16, lines 3-15).

43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock and Blumenau because Blumenau's teaching of a unique hardware address must be present in order to perform port login would increase the reliability in Gunlock's system by allowing a component of the computer system (e.g., host bus adapter) to access to the correct target device (e.g., logical volume) (col. 12, lines 25-31).

44. Gunlock and Blumenau did not teach the unique hardware address table stores the unique hardware address of authorized target devices. Blumenau et al (2002/0083339) taught a centralized unique hardware address access table (page 3, paragraph 22), contains the unique hardware addresses of each target device that the host is authorized to access (page 5, paragraphs 41, 44 and 45).

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau and Blumenau et al (2002/0083339) because Blumenau et al's (2002/0083339) teaching of storing unique hardware address corresponding to one or more target devices with which the host bus adapter is authorized to

access would increase the security of Gunlock's and Blumenau's systems by preventing a host device from accessing target device without authorization (page 7, paragraph 56).

46. Gunlock, Blumenau and Blumenau et al (2002/0083339) did not teach querying for available target devices. Blumenau et al, 6,665,714, taught from the host bus adapter, querying the fabric for available target devices and receiving at the host bus adapter an identification of available target devices (col. 6, lines 62-col. 7, line 12; col. 8, lines 35-36; col. 21, lines 67-col. 22, lines 14).

47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al, 6,665,714 because Blumenau et al's (6,665,714) method of querying the fabric for available target devices would increase the efficiency of Gunlock's, Blumenau's and Blumenau et al's (2002/0083339) systems by avoiding login attempt to unavailable target devices by the host.

48. As per claim 10, Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) taught the invention substantially as claimed in claim 9 above. Gunlock further taught wherein the unique hardware address is a port name (col. 8, lines 21-25).

49. As per claim 11, Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) taught the invention substantially as claimed in claim 9 above. Gunlock further taught wherein the unique hardware address is a node name (col. 8, lines 21-25).

50. As per claim 12, Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) taught the invention substantially as claimed in claim 9 above. Blumenau et al (6,665,714) further taught wherein the unique hardware address is a World-Wide Name (col. 6, lines 65-67; col. 22, lines 4-11).

51. It would have been obvious to one of ordinary skill in the art at the Blumenau et al (2002/0083339) et al and Blumenau et al (6,665,714) because Blumenau et al's (6,665,714) teaching of World-Wide Name would enhance Gunlock's, Blumenau's and Blumenau et al's (2002/0083339) systems by providing a unique identification for identifying each storage device (col. 22, lines 7-11).

52. As per claim 13, Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) taught the invention substantially as claimed in claim 9 above. Gunlock further taught wherein the target device is a storage device (col. 6, lines 17-24; col. 7, lines 19-20).

53. As per claim 15, Gunlock, Blumenau, Blumenau et al (2002/0083339) and Blumenau et al (6,665,714) taught the invention substantially as claimed in claim 9 above. Gunlock further

taught wherein the high speed network interconnect is a high speed optical network interconnect (col. 6, lines 17-21).

54. Applicant's arguments with respect to claims 1-5, 7-13, 15-20, 22 and 29-33, filed 2/12/07, have been considered but are not persuasive.

55. In the remarks, applicant argued that:

(1) The invention was conceived before the filing data of Blumenau et al (2002/0083339), December 22, 2000.

(2) The applicants and their counsel were diligent with respect to constructively reducing the invention to practice from a time just prior to December 22, 2000 to the filing data of this application on January 26, 2001.

(3) The cited prior arts fail to teach a unique hardware address table which holds the unique hardware addresses of target device that each respective host is authorized to access.

56. In response to points (1) and (2), the declaration under 37 CFR 1.131, filed October 18, 2007 is insufficient to overcome the reference of Blumenau et al (2002/0083339) because it fails to establish conception coupled with due diligence.

I. General Considerations.

a. See MPEP 2138. THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); Tucker v. Natta, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); Justus v. Appenzeller, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....").

b. See MPEP 2138. DILIGENCE REQUIRED IN PREPARING AND FILING PATENT

APPLICATION

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

II. Conception coupled with diligence.

Applicant attempts to establish diligence coupled with conception by submitting a declaration of Khannan Suntharam as evidence of facts. In particular page 2 of the declaration states:

a) I worked with Roger Fulghum, the lawyer responsible for supervising the preparation and prosecution of patent applications for Dell in Baker Botts's Houston office.

b) In November and December of 2000 and January of 2001, I researched the prior art related to the invention and prepared the patent application for the DC-02668 invention disclosure.

c) I worked on this application according to the following list of dates, hours worked, and description of work performed...

As stated in the previous office action, at most, the redacted documents (invention disclosure form DC-02668) submitted as exhibit A *may* be used to support conception of an invention. Specifically, pages 3 to 6 of the exhibit A shows the general idea of configuring specific hosts in the SAN to have access to specific storage devices was conceived by the applicants. However, this is not adequate to establish conception of the claimed invention. Applicant does not point to any locations of the Exhibit A in order to establish that the features of claims were conceived prior to the applied prior art dates. Applicant has not met the burden of showing possession of every feature recited in the counts, there is No clear explanation. There is no clear explanation as to how the redacted documents is established conception for every limitation of the claimed invention recited in the independent claims.

It is noted that in determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Although conception has not been clearly established, however, in order to further prosecution, the examiner provide some comments on applicants attempted showing of diligence.

The list of dates and hours worked shown on page 2 of the declaration leaves large gap of time unaccounted for between entries. Between 12/4/2000 to 1/13/2001, only a minimal of 5.7 total hours were worked for preparing the patent application. This is not considered as diligently worked to prepare the application. As stated in the MPEP 2138, "A 2-day period of lacking activity has been held to be fatal." "The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses." "Six days to execute and file application is acceptable." Because the entire period during which diligent is required is not accounted, diligent has not been established and therefore the declaration is ineffective in showing of diligence.

57. In response to point (3), applicant's argument has been considered and addressed to in paragraph 60 of the office action mailed on 5/18/2007.

58. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER
12/31/7